UNITED STATES PATENT AND TRADEMARK OFFICE

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10/766,677	01/27/2004	Naoyuki Nishikawa	B422-251	3038

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _27 January 2004_.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-10_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-10_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on _27 January 2004_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☒ All b) ☐ Some * c) ☐ None of:

        1. ☒ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____.

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Priority

1.   Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d),

which papers have been placed of record in the file.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or
> composition of matter, or any new and useful improvement thereof, may obtain a patent
> therefor, subject to the conditions and requirements of this title.

Claim 9 is rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. Claim 9 is drawn to functional

descriptive material NOT claimed as residing on a computer readable medium.

MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

> "Data structures not claimed as embodied in a computer-readable medium
> are descriptive material per se and are not statutory because they are not
> capable of causing functional change in the computer."

> "Such claimed data structures do not define any structural or functional
> interrelationships between the data structure and other claimed aspects of the
> invention which permit the data structure's functionality to be realized."

Claim 9, while defining a program (whatever is claimed; e.g., a computer

program, an algorithm, a medium, a program providing medium, a memory, etc.),

does not define a "computer-readable medium" and is thus non-statutory for that

reasons. A program (whatever is claimed; e.g., a computer program, an

algorithm, a medium, a program providing medium, a memory, etc.) can range

from paper on which the program is written, to a program simply contemplated

and memorized by a person. The examiner suggests amending the claim to

embody the program on "computer-readable medium" in order to make the claim

statutory.

"In contrast, a claimed computer-readable medium encoded with the data
structure defines structural and functional interrelationships between the data
structure and the computer software and hardware components which permit the
data structure's functionality to be realized, and is thus statutory." - MPEP
2106.IV.B.1(a)

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in
public use or on sale in this country, more than one year prior to the date of application for patent in
the United States.

4.   Claims 1, 3, 6-10 are rejected under 35 U.S.C. 102(b) as being anticipated

by Nakatsuma et al. (US 6,115,132).

Regarding claim 1, Nakatsuma '132 discloses a data processing

apparatus (client computers, fig. 1) which sends data over a network (a network

106, fig. 1) and prints the data on a remote printer (105, fig. 1), comprising:

print response means (the application program 704, fig. 8) for generating a

print job for performing a response process when the data is printed (i.e., the

application program 704 starts a print operation on the client computer 702 (102)

by using GDI 705; see col. 12, lines 1-2);

spooling means (Windows spooler 707, fig. 8) for generating a print

completion job by spooling print job generated by said print response means (i.e.,

GDI notifies the Windows spooler 707 and virtual print server print monitor 708 of

the print start; see col. 12, lines 2-4);

transferring data conversion means for converting the print completion job

generated by said spooling means into a format in which the job can be

transferred to the remote printer over the network (i.e., the network printer control

monitor 709 transfers print data to network printer in accordance with a print

communication protocol to print. Inherently, data pass on to the network are in

the form of electric signal. Therefore the print data must be converted into

electric signal before it can be transmitted);

remote transfer means (The network printer control monitor 709, fig. 7) for

transferring the print completion job converted into a transferrable format by said

transferring data conversion means using a predetermined transfer protocol (i.e.,

the network printer control monitor 709 passes the print data to the network

printer in accordance with a print communications protocol to print it at the

network printer 701; see col. 12, lines 39-41, fig. 7).

Regarding claim 3, Nakatsuma '132 discloses the data processing

apparatus, further comprising:

selection means (a setting display 207, figs. 2, 25-32) for selecting a

transfer protocol for remote transfer of the data (i.e., the client PC 102 transfers

print data of the job to the network printer 105. This data transfer may be

performed in accordance with a protocol dedicated to printing, such as LPR of

TCP/IP; see col. 23, lines 35-40).

Regarding claim 6, Nakatsuma '132 discloses the data processing

apparatus, further comprising:

transfer control means (the virtual print server service (client) 712, fig. 11)

for controlling a transfer parameter setting file and said remote transfer means by

referring to the transfer parameter setting file (i.e., the virtual print server service

(client) 712 checks at Step S3603 the parameter representative of the printer

name contained in the VPSOpenPrinter command received at Step S3601; see

col. 10, lines 59-67, fig. 36).

Regarding claim 7, Nakatsuma '132 discloses a remote print system,

comprising:

the data processing apparatus (client/server computers, fig. 1) and the

remote printer (network printer 105, fig. 1).

Regarding claims 8-9, claims 8-9 are the method claims of device claim 1.

Therefore, method claims 8-9 are rejected for the reason given in device claim 1.

Regarding claim 10, Nakatsuma '132 discloses a computer-readable

storage medium storing the computer program (CPU 200 controls to execute

application programs, printer driver programs, OSes, network printer control

programs and the like stored in a hard disk (HD) loaded in an HD drive 205 and

to temporarily store information, files and the like necessary for the execution of

programs in a RAM 202 as a storage means, col. 5, lines 63-67, col. 6, lines 1-3,

figs. 3-4).

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described
> as set forth in section 102 of this title, if the differences between the subject matter sought to
> be patented and the prior art are such that the subject matter as a whole would have been
> obvious at the time the invention was made to a person having ordinary skill in the art to which
> said subject matter pertains. Patentability shall not be negatived by the manner in which the
> invention was made.

6.   Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Nakatsuma et al. (US 6,115,132) in view of Ferlitsch (US 2002/0089692).

Regarding claim 2, Nakatsuma '132 does not disclose the data processing

apparatus, further comprising: recovery means for performing a recovery process

on a print completion job transferred by said remote transfer means as

necessary.

However, the above-mentioned claimed limitations are well known in the

art as evidenced by Ferlitsch '692. In particular, Ferlitsch '692 teaches the data

processing apparatus, further comprising: recovery means (a status detecting

print system component (SDPC) 520, fig. 8, paragraph [0086]) for performing a

recovery process on a print completion job transferred by said remote transfer

means as necessary (i.e., systems and methods for detecting the status of

printing devices and recovering from printing errors; see Abstract).

In view of the above, having the system of Nakatsuma '132 and then given

the well-established teaching of Ferlitsch '692, it would have been obvious to one

having ordinary skill in the art at the time of the invention was made to modify the

system of Nakatsuma as taught by Ferlitsch to include: the data processing

apparatus, further comprising: recovery means for performing a recovery process

on a print completion job transferred by said remote transfer means as

necessary, since Ferlitsch '692 stated on page 1, paragraph [0003] that such a

modification would making the cost of the network very manageable.

7.   Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Nakatsuma et al. (US 6,115,132) in view of Qiao (US 2003/0030843).

Regarding claim 4, Nakatsuma '132 does not disclose the data processing

apparatus, wherein said remote transfer means uses a file transfer protocol or a

mail distribution protocol.

However, the above-mentioned claimed limitations are well known in the

art as evidenced by Qiao '843. In particular, Qiao '843 teaches the data

processing apparatus (client 2-1, fig. 1), wherein said remote transfer means

uses a file transfer protocol (i.e., Converts the job sent from the ExPM client 2-1

by IPP into the protocol such as HTTP/FTP and transfers it to the ExPM server

31; see page 9, paragraph [0241]) or a mail distribution protocol (i.e., the ExPM

client 2-1 sends the printing command mail to the target printer using Simple Mail

Transfer Protocol SMTP; see page 4, paragraph [0100]).

In view of the above, having the system of Nakatsuma '132 and then given

the well-established teaching of Qiao '843, it would have been obvious to one

having ordinary skill in the art at the time of the invention was made to modify the

system of Nakatsuma '132 as taught by Qiao '843 to include: the data processing

apparatus, wherein said remote transfer means uses a file transfer protocol or a

mail distribution protocol, since Qiao '843 stated on page 1, paragraph [0019]

that such a modification would ensure a step of converting the printing service

request of the client using the Internet Printing Protocol to a protocol which

allows circumventing the firewall of the print server, and transferring the request

to the print server according to the access.

8.   Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Nakatsuma et al. (US 6,115,132) in view of Jacobsen (US 2004/0095595).

Regarding claim 5, Nakatsuma '132 does not disclose the data processing

apparatus, further comprising: encipher means for enciphering a print completion

job transferred by said remote transfer means.

However, the above-mentioned claimed limitation is well known in the art

as evidenced by Jacobsen '595. In particular, Jacobsen '595 teaches the data

processing apparatus, further comprising: encipher means (i.e., when a print job

is sent to the printer and designated for printing at a later time, the print job is

assigned a key identification number (KEY) and then encrypted by the processor

based on the encryption algorithm and the KEY; see page 1, paragraph [0008]).

In view of the above, having the system of Nakatsuma '132 and then given

the well-established teaching of Jacobsen '595, it would have been obvious to

one having ordinary skill in the art at the time of the invention was made to

modify the system of Nakatsuma '132 as taught by Jacobsen '595 to include: the

data processing apparatus, further comprising: encipher means for enciphering a

print completion job transferred by said remote transfer means, since Jacobsen

'595 stated on page 1, paragraph [0004] that such a modification would ensure a

user generates a document containing sensitive and confidential financial

information that should not be seen by the general employees or general public.

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

McAfee et al. (US 2003/0206312) discloses method and apparatus for

integrating remote print-on-demand services into a local printer driver.

Fujiwara (US 7,242,498) discloses job executing system and job executing

method.

Al-Kazily et al. (US 2002/0135797) discloses mailbox printing services for

information appliances.

Coker (US 6,897,974) discloses print system for printing to a remote

printing apparatus.

10.   Any inquiry concerning this communication or earlier communications from

the examiner should be directed to Allen H. Nguyen whose telephone number is

571-270-1229. The examiner can normally be reached on M-F from 9:00 AM-

6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, King Poon can be reached on (571)-272-7440. The fax

phone number for the organization where this application or proceeding is

assigned is 571-273-8300.

Information regarding the status of an application may be obtained from

the Patent Application Information Retrieval (PAIR) system. Status information

for published applications may be obtained from either Private PAIR or Public

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free). If you would like assistance from a USPTO Customer Service

Representative or access to the automated information system, call 800-786-

9199 (IN USA OR CANADA) or 571-272-1000.

AN

09/19/2007

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